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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,622	03/22/2001	Mark E. Cannon	CANN-0208	3984

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EXAMINER	
FLEURANTIN, JEAN B	

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/814,622	CANNON, MARK E.	
	Examiner	Art Unit	
	JEAN B. FLEURANTIN	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *15-22,96,97 and 101-121* is/are pending in the application.

4a) Of the above claim(s) *121* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-22,96,97 and 101-120* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This is in response to Applicant(s) arguments filed on 8/21/06.

The following is the current status of claims:

Claims 12, 14, 88-95 and 98-100 have been canceled.

Claims 101-117 have been withdrawn.

Claims 119-121 have been added (as indicated in page 3, "applicants' remarks"). The Examiner discusses the limitations of newly added claims 119-121 as indicated in the following sections listed.

Claims 15-22, 96-97 and 101-121 remain pending for examination.

Response to Applicant' Remarks

Applicant's arguments filed 8/21/06, with respect to claims 15-22, 96-97 and 101-121 have been fully considered but they are not persuasive for the following reasons, see sections A (restriction and rejections) and B (response to arguments).

A. Newly submitted claim 121 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: a program product including an advertising plan optimization mechanism for use by a media planner, the program product comprising the advertising plan optimization mechanism connected to a user interface for use by the media planner in generating an advertising plan; the advertising plan optimization mechanism utilizes at least one database made up of non-real time data in creating the advertising plan, scheduling the distribution of the advertising massage, modifying the advertising plan, and evaluating the resulting advertising plan.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 121 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-22, 96-97 and 101-120 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106:

> Products may be either machines, manufactures, or compositions of matter.
> A *machine* is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

As per claims 15, 101 and 119

The independent claims 15, 101 and 119, the method, program and system as recited in the claims, in view of the above cited MPEP section is not statutory, because "a program product comprising: signal bearing media bearing the advertising optimization mechanism" is not statutory, because the claimed physical structure implementation does not appear to be functional descriptive material and does not produce any tangible result. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-

readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

All dependent claims are rejected under the same rational.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15-22, 96, 97 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,463,585 issued to Hendricks et al., (hereinafter "Hendricks") in view of US Patent No. 5,155,591 issued to Wachob, (hereinafter "Wachob").

As per claim 15, Hendricks discloses "a program product" (see col. 4, lines 29-32) comprising:

"an advertising plan optimization mechanism [[for generating a]] that creates an advertising plan" (i.e., use the available feeder channels for the programs that yield the largest maximum rank; see col. 39, lines 50-57) "[[for providing]], wherein:

"the advertising plan optimization mechanism schedules a distribution of [[advertisement]] advertising message [[to a preselected group of]] on one or more broadcast or other shared media vehicles for exposure to potential [[message recipients]] customers, wherein the potential customers receive the same advertising massage (i.e., broadcasting programs; see col. 28, lines 34-45),

"an advertisement message to a selected group of potential message recipients" (i.e., select the advertisement for which a group with a higher value has already been selected (preselected group); see col. 37, line 58 to col. 38, line 60),

"the advertising plan optimization mechanism [[modifying an]] creates or modifies the advertising the message [[for advertising the message to the preselected group]] by modifying the distribution of the advertising message within an advertising schedule" (i.e., changing (modifying) program based on viewer preference; see col. 21, lines 8-11) and "evaluating resulting advertising plan to achieve one of an improved and an optimal advertising plan for the massage" (i.e., determine the advertisement, targeting category combination that results in the highest overall ranking; see col. 37, lines 13-57).

Hendricks fails to explicitly disclose signal bearing media bearing the advertising optimization mechanism. However, Wachob discloses signal bearing media bearing the advertising optimization mechanism (see Wachob col. 2, lines 24-36). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Hendricks by signal bearing media bearing the advertising optimization mechanism as disclosed by Wachob (see col. 9, lines 36-39). Such a modification would allow the system of Hendricks to provide a method for targeting specific commercial advertisements to demographically selected audiences (see Wachob col. 1, lines 25-28). Therefore, improving the reliability of the method and apparatus for analyzing data and advertising optimization.

As per claim 16, in addition to claim 15, Hendricks further discloses "transmission media" (see col. 9, lines 34-46).

As per claim 17, in addition to claim 15, Hendricks further discloses "recordable media" (see col. 28, lines 52-67).

As per claim 18, Hendricks further discloses "a plurality of indices which are utilized by the advertising plan optimization mechanism to iteratively modify the advertising plan" (see col. 20, lines 43-66).

As per claim 19, Hendricks discloses "the plurality of indices comprises at least one of an exposure valuation index" (see col. 21, lines 8-11), "an audience valuation index, an exposure recency index, a response index and a cost index" (see col. 20, lines 44-48).

As per claim 20, Hendricks further discloses "a data conversion mechanism comprising a mechanism for converting data from a first data format t a second data format" (i.e., converted from a waveform (first format) into a digital binary format (second format); see col. 19, lines 1-7).

As per claim 21, Hendricks further discloses "the first data format is a plurality of media exposure records" (see col. 19, lines 1-2) "the second data format is a plurality of variable length records which describe changes in media-related access data for a target audience" (see col. 25, lines 63-65).

As per claim 22, Hendricks further discloses "the first data format is a plurality of media exposure records" (see col. 19, lines 1-2) and "the second data format is a binary representation of the plurality of media exposure records" (see col. 19, lines 2-4).

As per claim 96, the limitations of claim 96 are similar to claims 15-19, therefore, the limitations of claim 96 are rejected in the analysis of claims 15-19, and this claim is rejected on that basis.

As per claim 97, Hendricks discloses "the media exposure records comprise television viewing records produced by A.C. Nielsen" (see col. 35, lines 16-65).

As per claim 118, the limitations of claim 118 are similar to claim 19, therefore, the limitations of claim 118 are rejected in the analysis of claim 19, and this claim is rejected on that basis.

As per claims 119-120, the limitations of claim 119-120 are similar to claims 15-22, therefore, the limitations of claims 119-120 are rejected in the analysis of claims 15-22, and these claims are rejected on that basis.

B. Claims as amended overcome the 35 U.S.C. 112 rejection(s). Thus, the 112 rejection(s) has/have been withdrawn.

In response to applicant's argument, page 12, paragraph 2, that the "... suggestion to make the claimed combination and the reasonable expectation success must both be found in the prior art ...", the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.1992). In this case, Hendricks fails to explicitly disclose signal bearing media bearing the advertising optimization mechanism. However, Wachob discloses signal bearing media bearing the advertising optimization mechanism (see Wachob col. 2, lines 24-36). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Hendricks by signal bearing media bearing the advertising optimization mechanism as disclosed by Wachob (see col. 9, lines 36-39). Such a modification would allow the system of Hendricks to provide a method for targeting specific commercial advertisements to demographically selected audiences (see Wachob col. 1, lines 25-28), therefore, improving the reliability of the method and apparatus for analyzing data and advertising optimization.

Furthermore, Hendricks discloses a system and method for delivering targeted advertisements in a television network, and to efficiently convey targeted advertisements to a desired audience; see cols. 1 and 2, lines 30-31 and 25-26. Wachob discloses a method for targeting specific commercial advertisements to demographically selected audiences; see col. 1, lines 25-27). Thus, the combination of Hendricks and Wachob discloses the claimed invention.

Applicant stated, page 13, paragraph 2, "Hendricks does not deal with scheduling a distribution of an advertising message". It is noted that Hendricks discloses assigning programs in time slots; see col. 11, lines 40-54. Further, in column 28, lines 32-39, Hendricks discloses an advertisement assignment module, clocking information regarding broadcasting programs.

Applicant stated, page 13, paragraph 2, that Hendricks does not modify the advertising plan by "modifying the distribution of the advertising message within the advertising schedule", and "evaluating a resulting advertising plan to achieve one of an improved and an optimal advertising plan for the message". That is, as now recited, claim 15 requires modification of the distribution of the advertising message and evaluation of the overall plan for the advertising message. This is not taught or suggested by Hendricks or Wachob." It is noted that the features upon which applicant relies (i.e., modifying the distribution of the advertising message within **the** advertising schedule; and evaluation of the **overall** plan for the advertising message) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

MPEP 2111: During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecussion and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

For the above reasons, it is believed that the last Office Action was proper.

CONTACT INFORMATION

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571-272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jean Bolte Fleurantin
Patent Examiner
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November 8, 2006